UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,335	01/22/2001	Erik Petersen	459042000100	9707

25227 7590 08/11/2004	**EXAMINER**
MORRISON & FOERSTER LLP	JANVIER, JEAN D
1650 TYSONS BOULEVARD	

SUITE 300	**ART UNIT** / **PAPER NUMBER**
MCLEAN, VA 22102	3622

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 January 2001*.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
   application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Priority

This Application claims priority, under 119(e), to a series of Provisional Applications including 60/177, 268, filed on January 21, 2000.

Specification

Status of the claims

Claims 1-10 are pending in the Instant Application.

Claim Objections

The claims are objected to because of the following informalities:

Regarding the claimed invention, it is unclear whether the off-line merchant refers to a merchant without an online store or a merchant with no access to a computer and without an online store.

First, a merchant without an Internet or online store is supported in the specification as suggested by this excerpt-

"In yet another embodiment of the invention, there is a system for bringing off-line merchants on-line. The system includes, for example, **a computer that gathers** information about an off-line merchant, **a server** storing the merchant information

gathered by the computer, and an on-line store service accessing the information on the

server in order to create an on-line site that may be accessed on-line by customers,

potential customers and/or other persons wishing to view information about and/or

initiate transactions with the off-line merchant."

Second, concerning claim 3, the limitations recited therein are performed by a

sales unit, which receives the information from the off-line merchants and wherein a

consultant or Web master or administrator may review or manipulate the received data or

information as supported by the specification. And the claim is examined accordingly.

For Examination purpose, the Examiner first considers a merchant without an

online store. Second, provided that the Applicant can show support for this disclosure

under 112(1), the Examiner considers a merchant with no access to a computer and

without an online store (claims 1-5).

Throughout the claimed invention, "customers off-line" or "off-line customers" is

interpreted as --merchants off-line-- or --off-line merchants--.

Concerning claim 8, the term "user" is interpreted as --merchant--.

Concerning claims 9 and 10, the term "off-line user" is interpreted as --off-line

merchant--.

Concerning claim 4, the preamble should apparently be written as follows: --A

computer readable medium storing computer program codes to perform the steps of:--.

Appropriate corrections are required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section
122(b), by another filed in the United States before the invention by the applicant for
patent or (2) a patent granted on an application for patent by another filed in the United
States before the invention by the applicant for patent, except that an international
application filed under the treaty defined in section 351(a) shall have the effects for
purposes of this subsection of an application filed in the United States only if the
international application designated the United States and was published under Article
21(2) of such treaty in the English language.

Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Cohen, US Patent

6, 263, 352B1.

As claims 1-8, Cohen discloses a system for assisting a merchant in setting up an

electronic online storefront that is customized to the merchant's business without requiring the

merchant to have any programming background or to host himself the online storefront

(managing or monitoring the online store or online storefront on behalf of the merchant). The

system employs a store builder wizard to guide the merchant through a series of questionnaires

designed to extract or collect or gather information or data pertaining to the merchant's business

(collecting off-line information from a merchant). Further, the system employs a page generator

to create active server pages (ASPs or web pages) that form the customized online storefront

using the information collected from the merchant through the series of questionnaires. The page

generator creates the active server pages (ASPs) from a set of templates that are generic to

formation of an online storefront. The templates are written as an extension to the active server

page technology in a combination of hypertext language and scripting language. The page

generator then executes the scripting program using the merchant data as input to produce a

customized set of active server pages (web pages) that will become part of a web site accessible

by a plurality of users on the Internet to request or view information, such as product information

stored therein and related to the merchant, wherein the requested product information is

displayed on one of the customized web pages corresponding to the merchant's storefront and in

accordance with the data collected or gathered from the merchant. In short, the resulting active

server pages contain the hypertext language and are stored together to form an active server

application customized to the merchant's storefront and in accordance with the data provided by

the merchant (See abstract; col. 1: 14-31).

Further, the system employs a store builder wizard to guide a merchant through a series

of questionnaires designed to extract information pertaining to the merchant's business. For

example, the questionnaires might be written as a series of HTML documents that require the

merchant to enter data concerning the business' address, inventory, pricing, preferred method of

payment, and so forth. The answers to the questions are stored in a data file related to a database

and coupled to a server (uploading the off-line data collected from the merchant in a server

database). Here, the merchant merely provides or enters information via a user-friendly interface

(store builder wizard) and a customized storefront is automatically generated or created.

Moreover, the store builder wizard and page generator (pieces of software) are coupled to

a host server, which creates a customized storefront from the merchant provided data and

thereafter manages the storefront on behalf of the merchant or customer (monitoring the online

store on behalf of the off-line merchant).

Col. 2: 64 to col. 3: 55; fig. 3).

The page generation system is described within an exemplary environment of online

commerce. In this environment, a merchant desires to create an online storefront that is

customized to its business.

FIG. 3 shows an online commerce system 40 in which customers shop for goods and

services from merchants over the Internet 42. The online commerce system 40 exhibits two

possible scenarios. In one embodiment, it is that the merchant creates and manages its own

online storefront. Merchant 1 represents this case. A host computer 44, which resides at

merchant 1, is loaded with a store builder module 46 that aids the merchant in creating an online

storefront. The merchant enters data relevant to its business and the store builder module 46

generates a storefront 48 that is customized to the merchant's business based on the entered data.

The merchant storefront 48 is kept and managed at the merchant's computer 44. In another

embodiment, the merchant has no expertise in managing an online storefront. Hence, the

merchant relies on the expertise of an Internet Service Provider (ISP). Merchant computer 50 and

ISP computer 52 represent this case. The ISP computer 52 is configured with the store builder

module 56. The merchant uses a local Web browser 54 to remotely access the store builder

module 56 on the ISP computer 52 to enter data pertaining to the merchant's business. The store

builder module 56 creates a merchant's storefront 58 based on the data submitted by the

merchant over the Internet 42. The storefront 58 is maintained at the ISP computer 52 where it is

made available to online users or customers accessing the Internet. Online customers access the

storefronts electronically over the Internet 42 from their computers, as represented by customer

computers 60(1), 60(2), . . . , 60(N). Each customer computer is configured with a Web browser

62(1), 62(2), . . . , 62(N). To shop and order goods from merchant 1 (requesting information from

the merchant), a customer (e.g., customer 1) uses his/her Web browser to access the merchant

storefront 48 maintained on the merchant host computer 44. On the other hand, to shop and order

goods from merchant 2 (whose online store is managed or hosted by the ISP), a customer (e.g.,

customer 2) uses the Web browser to access the merchant storefront 58 maintained on the ISP

host computer 52 (downloading the data from a storage device or RAM related to the merchant's

terminal 50 to the server or ISP server 52 where the data are made accessible to an online user or

customer 2 using a third party device or terminal 60(2) of fig. 3 and the server 52 is configured to

receive a request or purchase order from the presented data or merchant's inventory when the

online user clicks on the data displayed on the merchant's newly created online storefront hosted

by the ISP 52 (claims 6-7 limitations)).

(Col. 5: 66 to col. 6: 41).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or
> described as set forth in section 102 of this title, if the differences between the subject
> matter sought to be patented and the prior art are such that the subject matter as a whole
> would have been obvious at the time the invention was made to a person having ordinary
> skill in the art to which said subject matter pertains. Patentability shall not be negatived
> by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the

claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)

and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-5 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Cohen, US Patent 6, 263, 352B1.

As claims 1-5 and 9, Cohen discloses a system for assisting a merchant in setting up an

electronic online storefront that is customized to the merchant's business without requiring the

merchant to have any programming background or to host himself the online storefront

(managing or monitoring the online store or online storefront on behalf of the merchant). The

system employs a store builder wizard to guide the merchant through a series of questionnaires

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customized set of active server pages (web pages) that will become part of a web site accessible

by a plurality of users on the Internet to request or view information, such as product information

stored therein and related to the merchant, wherein the requested product information is

displayed on one of the customized web pages corresponding to the merchant's storefront and in

accordance with the data collected or gathered from the merchant. In short, the resulting active

server pages contain the hypertext language and are stored together to form an active server

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the merchant (See abstract; col. 1: 14-31).

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of questionnaires designed to extract information pertaining to the merchants business. For

example, the questionnaires might be written as a series of HTML documents that require the

merchant to enter data concerning the business' address, inventory, pricing, preferred method of

payment, and so forth. The answers to the questions are stored in a data file related to a database

and coupled to a server (uploading the off-line data collected from the merchant in a server

database). Here, the merchant merely provides or enters information via a user-friendly interface

(store builder wizard or intermediary or electronic agent or sales representative) and a

customized storefront is automatically generated or created.

Moreover, the store builder wizard and page generator (pieces of software) are coupled to

a host server, which creates a customized storefront from the merchant provided data and

thereafter manages the storefront on behalf of the merchant or customer (monitoring the online

store on behalf of the off-line merchant).

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the merchant), a customer (e.g., customer 1) uses his/her Web browser to access the merchant

storefront 48 maintained on the merchant host computer 44. On the other hand, to shop and order

goods from merchant 2 (whose online store is managed or hosted by the ISP), a customer (e.g.,

customer 2) uses the Web browser to access the merchant storefront 58 maintained on the ISP

host computer 52.

(Col. 5: 66 to col. 6: 41).

As per claims 1 and 3-4, although Cohen discloses the steps of receiving data or

information from a merchant (without an online store), storing in a server database the received

information and using the said information to create a customized online storefront for the

merchant and managing by the server or host (online service provider) the online storefront on

behalf of the merchant, however, Cohen does not expressly teach a process for gathering, for

storage, by a sales person information from an off-line customer or merchant (a merchant

without access to a computer and without an online store).

As per claims 9-10, although Cohen discloses the steps of receiving data or information

from a merchant (without an online store), storing in a server database the received information

and using the said information to create a customized online storefront for the merchant **and**

managing or monitoring by the server or host (online service provider) the online storefront on

behalf of the merchant, wherein the storefront or online site is accessible by online users to

request information and/or purchase goods or services displayed thereon and associated with the

merchant, however, Cohen does not expressly teach forwarding a copy of a visitor's or user's

request to the off-line merchant via off-line access transmission medium and receiving a

response from the off-line merchant related to the said request and updating the online site or

storefront data accordingly.

However, the process of establishing an online storefront over the Internet for a small

retailer or independent seller is old and well taught in the industry for many years. For example,

a small retailer or independent seller, with limited budget and/or no computer background, will

have an online service provider set up, host and manage an online storefront or store on his

behalf, which gives the small retailer an Internet presence and allows him to sell his products or

services online. To do so, the interested retailer transmits via regular mail, hand delivery or fax

or any other available communication means, data, such inventory, prices, acceptable payment

instruments, a local POS address, business name, etc., regarding his business to a contact person

or sales person or Web Master associated with the online service provider, wherein the sales

person or Web Master reviews the transmitted data prior to storing them in a terminal where they

are used to design or construct the customized online storefront for the retailer. Subsequent to

this construction or creation, the retailer is invited to review the work before it is being uploaded

to the online service provider system (server) where the newly created online storefront, having

an identifier or address, is displayed on one or more web pages related to a web site of the online

service provider where the storefront is readily available or accessible to online users to view and

request information and/or order products or services from the retailer's inventory. And the

retailer is charged according to a business agreement between the online service provider and the

retailer.

Further, when an online user visiting the online storefront requests information or makes

a purchase, the online service provider handles the request and/or the purchase order using the

retailer's data stored thereon. In the case of a request for more information that is not currently

loaded or stored in the online service provider database, the request is forwarded for completion

to the retailer using conventional communication means, such a telephone call, fax or e-mail, etc.

Upon receiving the requested information from the retailer via conventional communication

means, the online service provider contacts the interested customer or user preferably via e-mail

and the retailer's data already stored in the database is updated accordingly to reflect this

transaction, especially if the online service provider gets paid per transaction. Moreover, if the

user or visitor orders a product online (or if the product is out of stock) at a web page associated

with the retailer's online storefront, then the online service provider forwards the purchase order

to the retailer for fulfillment and shipping to the user. And the online service provider system

updates the retailer's data or inventory stored in the online service provider server database to

reflect this transaction, especially if the online service provider receives commissions based on

each transaction. (See Galaxymall.com for relevant details).

"Official Notice".

Therefore, an ordinary skilled artisan would have been motivated at the time of the

invention to incorporate the above disclosure into the system of Cohen so as to collect, by a sales

agent or representative working for an online service provider, off-line data transmitted via

regular mail, hand delivery or fax (off-line access transmission medium) from an off-line

merchant desiring to establish an online storefront on the Internet, wherein the collected data are

reviewed by the sales agent or system administrator or Web Master prior to storing them in a

server database related to the online service provider (Host) and wherein the stored data are later

retrieved (by the Web master) and used to create a customized online storefront for the off-line

merchant having displayed thereon the merchant's business description, inventory, prices,

acceptable payment instruments, etc., and wherein the newly created online storefront is

monitored and managed by the online service provider personnel and made available at a web

site related to the online service provider to online users to request information and/or purchase

goods or services displayed thereon and associated with the off-line merchant, and wherein the

host or server or online service provider forwards, via a telephone call, fax, etc., a copy of a

user's request or purchase order for fulfillment to the off-line merchant and in turn receives a

response from the off-line merchant related to the request (receives the requested information

that was unavailable from the server data storing information about the off-line merchant's

business) or purchase order, especially if the ordered good is out of stock and that the delivery

will be delayed or if the provider receives compensation per transaction, and wherein the off-line

merchant's received response (related to the user's request or purchase order) is utilized to

update the online site or storefront data stored in the server database accordingly, thereby

enabling a small retailer or independent seller with limited budget or resources and/or with no

computer access or background to establish an online storefront, created, hosted and managed by

the host or online service provider, over the Internet wherein he can provide information

regarding his business activities or sell his products or services seamlessly in real-time to

millions of online users throughout the world on a twenty-four hours a day and seven days a

week basis, while taking advantage of this great exposure to improve or increase his business

bottom line.

Conclusion

Although the following references were not officially used in the office action, they were

considered as relevant prior art. Applicant is further directed to review these references.

Visit Galaxymall.com in business for many years.

US Patent 5, 937, 391A to Ikeda discloses a mall system comprising a plurality of

independent shops managed and controlled by a mall administrator and wherein a shop owner is

not required to have his own server or to host his own shop.

Any inquiry concerning this communication from the Examiner should be directed to

Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally

be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner

by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached
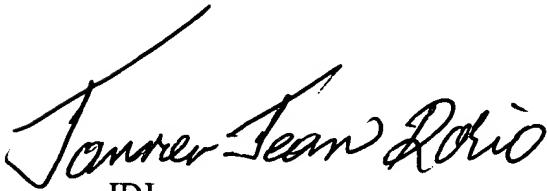
at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 308-

1113. Further, the following fax numbers can be used, if need be, by the Applicant(s):

After Final-   703-872-9327

Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325

JDJ
06/10/04